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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,542	07/24/2003	Masashi Watanabe	YMOR:236A	8201

6160 7590 08/20/2004

PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805

EXAMINER

TUPPER, ROBERT S

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,542

Applicant(s)

WATANABE ET AL.

Examiner

Robert S Tupper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-23 and 25-30 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/048,583.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2652

1. Claims 18-22, 26, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following are indefinite: "from an open surface side of the frame body" (claims 18 and 19, lines 4 and 7 respectively – no antecedent basis, location unclear, and unclear what structure being claimed), "a space created by embedding the head portions of the screws (claim 21, lines 2-3 – no antecedent basis, and location unclear), "space created by the thinly formed part of the yoke" (claim 26, lines 2-3 – no antecedent basis, and location unclear), and "each or the yoke" (claim 29, line 10 – unclear what is being claimed).

Further, concerning claims 18 and 19, the recitation that the yoke is attached to a "side" of the frame is misleading and misdescriptive. The lower yoke is attached to the bottom surface of the frame.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 17, 18, and 28 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by LIN (6,125,016).

Note figures 1, 3, and 5. LIN shows a disk drive an actuator (27) having a pair of yokes (48, 50), permanent magnets (44,46), and a movable coil (42). The yokes are attached to the outer frame (36,38) and are located in holes in the outer frame.

4. Claims 17, 18, 22, 23, and 27-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by BROWN (6,304,421).

Note figures 1, 5-9, and 11. BROWN shows a disk drive an actuator (122) having a pair of yokes (124,128), permanent magnet (126), and a movable coil (120). The yokes are attached to the outer frame (102,104) and are located in holes in the outer frame. The yokes have thicker center portions (144,146) centered on the permanent magnet. The gaps between the protruding portion of the yokes and the frame are sealed using an adhesive sheet (see column 7 lines 27-30).

Note that BROWN discloses that it is known in the prior art to have yokes (without a thicker center portion) of the actuator located in a hole in the outer frame sealed with an adhesive sheet.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROWN (6,304,421).

BROWN shows a disk drive with actuator structure substantially as claimed. BROWN differs in not: (A) specifying the exact structures used to attach the yokes (re claims 19 and 20), and (B) configure the thicker center portion of the yokes as a separate member (re claim 25).

Concerning (A), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the listed attachment structures. The motivation is as follows: Attaching the yokes using screws is extremely old and well know. The Examiner takes Official notice of such.

Concerning (B), it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the thicker center portion of the yokes as a separate member. The motivation is as follows: these are art recognized equivalents

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that operate in the same manner and produce the same results without any unexpected results.

8. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 21 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S Tupper whose telephone number is 703-308-1601. The examiner can normally be reached on Mon - Fri, 6:00 AM - 3:30 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "R.S. Tupper".

Robert S Tupper
Primary Examiner
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rst